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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,400	05/09/2001	William L. Trepicchio	GFN-5405CP	5404

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LAHIVE & COCKFIELD
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BOSTON, MA 02109

EXAMINER

WHISENANT, ETHAN C

ART UNIT PAPER NUMBER

1634

DATE MAILED: 07/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SUPPLEMENTAL
Office Action Summary

Application No.

09/852,400

Applicant(s)

TREPICCHIO ET AL.

Examiner

Ethan C. Whisenant

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____

SUPPLEMENTAL ELECTION/RESTRICTION

- 1.** This election/restriction requirement replaces the election/restriction requirement mailed 01 JUL 02 (i.e. paper no. 2).

ELECTION/RESTRICTION

- 2.** Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I.** **Claim(s) 1-42** drawn to method(s) and kit(s) which comprises measuring the expression level of a particular marker (i.e. gene) associated with psoriasis or a TH-1 associated condition, classified in at least, for example, Class 435, subclasses 6 and 7.1 and Class 536, subclass 23.1 and 24.3.
 - II.** **Claim(s) 43-47** drawn to method(s) and kit(s) for treating a subject with psoriasis or a TH-1 associated condition or a subject at risk thereof, classified in at least, for example, Class 514, subclasses 2 and 44.
- 3.** Inventions I and II encompass patentably distinct methods which have different goals and intermediate steps.
- 4.** Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
- 5.** The applicant is hereby require to elect for examination a single invention for examination (i.e. either the invention of Group I or Group II). In addition, the applicant is hereby required to elect a single marker for prosecution on the merits (i.e. a single marker must be elected) because each marker is a patentably distinct entity with unique structural characteristics.


While this requirement is made in view of the explosive growth of sequence databases in recent years and in view of the fact that searches for multiple sequences/markers per application is now unduly burdensome on the office and its examiners, it is proper in light of statute, "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." 35 U.S.C. 121. Pursuant to this statute, the rules provide that "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant . . . to elect that invention to which his claim shall be restricted." 37 CFR 1.142(a). See also 37 CFR 1.141(a). Absent evidence to the contrary, each marker recited in the claims is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

6. The applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.


ETHAN C. WHISENANT
PRIMARY EXAMINER